06-25-07

AF/3629

PATENT

APPEAL FROM THE PRIMARY EXAMINER TO THE BOARD OF PATENT APPEALS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of Sudesh KAMATH et al.	Examiner: Naresh VIG Art Unit: 3629
For: **METHODS AND SYSTEMS FOR ONLINE EXPRESS ORDERING OF GOODS AND SERVICES**	Confirmation No.: 8354 Customer No.: 53156
Serial No.: 09/833,034 Filed: April 10, 2001 Atty. Docket No.: ORCL5665CIP	**APPEAL BRIEF**

CERTIFICATE OF EXPRESS MAIL PURSUANT TO 37 CFR §1.10

I hereby certify that this document is being deposited in the U.S. Postal Service as "Express Mail Post Office to Addressee", Label No. **EO 935 512 415 US**, addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450, on **June 22, 2007**.

Rita J. Miller

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant requests an extension for response within first month from June 16, 2007 to July 16, 2007. The fees due under 37 C.F.R. §1.17(a)(1) in the amount of $120.00 (Fee Code 1251) are provided herewith.

06/26/2007 EAREGAY1 00000081 09833034
01 FC:1402 500.00 OP
02 FC:1251 120.00 OP

This is an Appeal Brief in support of the Notice of Appeal filed April 12, 2007. The fees due herewith under 37 C.F.R. §41.20(b)(2) in the amount of $500.00 (Fee Code 1402) are provided herewith.

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A. Real Party in Interest

The real party in interest is Oracle International Corporation; a corporation that is organized under the laws of the state of California and that has its principal place of business at 500 Oracle Parkway, Redwood Shores CA 94065. The real party in interest, Oracle International Corporation, obtained the entire right, title and interest in and to the present patent application by virtue of an assignment from the original assignee, Oracle Corporation, executed on February 18, 2003, and recorded in the United States Patent and Trademark Office on March 4, 2003, at reel/frame 013808/0035. The original assignee obtained the entire right, title and interest in and to the present application by virtue of an assignment from the inventors to Oracle Corporation executed on August 3, 2001, and recorded in the USPTO on August 9, 2001, at reel/frame 012077/0257.

B. Related Appeals and Interferences

There are no related appeals and interferences.

C. Status of Claims

Claims 1-69 were originally presented for examination. The current status of the claims is as follows: claims 1, 3-5, 7, 9-24, 26-28, 30, 32-47, 49-51, 53 and 55-69 are pending and claims 2, 8, 25, 31, 48 and 54 are canceled. The rejection of each of the claims 1, 3-5, 7, 9-24, 26-28, 30, 32-47, 49-51, 53 and 55-69 is appealed herewith.

D. Status of Amendments

This application was filed on April 10, 2001. A first Office Action was mailed on April 23, 2002, and a responsive Amendment was filed on July 31, 2002. A second Office Action was mailed on October 16, 2002, and a responsive Amendment was filed on February 13, 2003. A final Office Action was mailed on June 18, 2003, and a Notice of Appeal was filed on September 4, 2003, followed by an Appeal Brief on December 3, 2003. Presumably in response to the Appeal Brief, an Office Action was mailed on November 17, 2004 (thereby re-opening prosecution), and a responsive Amendment was filed on February 17, 2005. A telephone conference with the Examiner on February 24, 2005 was followed by a second Office Action, which was mailed on March 1, 2005. A Request for New Office Action was filed on December 5, 2005. In response thereto, the Office mailed a new Office Action on February 10, 2006, and a responsive Amendment was filed on March 31, 2006. An Office Action was mailed on June 8, 2006, and a responsive Amendment was on filed September 8, 2006. Another final Office Action, from which the present appeal is taken, was mailed on November 15, 2006. A Notice of Appeal was timely filed on April 12, 2007.

E. Summary of the Claimed Subject Matter

1. Independent Claim 1

Claim 1 defines a computer-implemented method of processing an online purchase request C1 – C8 (Fig. 1, page 9, lines 9-15) from a customer 202 (Fig. 2) to a vendor 204 (Fig. 2) over a computer network 206 (Fig. 2). The method of processing an online purchase request from a customer, according to an embodiment of the present invention, may include the steps of receiving a first online purchase request C1 for purchase of a first item. As shown at S81 in Fig. 8 and as described in the specification beginning at page 20, line 7, the customer may place a purchase request. From the point of view of the vendor 204, the computer implemented method of claim 1 may include a step of receiving, over the computer network 206, a first online purchase request for a first item. As detailed in the specification at page 10, lines 3-9, the term "item", according to the present invention, includes any goods or services, whether purchased individually or in combination. For example, C1 may denote Customer 1 requesting the purchase of a single item or may denote, for example, a combined purchase request for several items, such as a laptop computer 602, a printer 604 and a scanner 606, as shown in Fig. 6. Responsive to receiving the first online purchase request, the claimed computer-implemented method calls for providing a bifurcated order processing route that requests the customer to choose a first order processing route or a second order processing route, the first order processing route (YES branch, step S82 in Fig. 8) causing the first online purchase request to be processed according to an express processing procedure that requires no further input by the customer to execute the first online purchase request, the second order processing route (NO branch, step S82 in Fig. 8) causing the first online purchase request to be placed in a shopping cart (See step S8 in Fig. 8)

that allows one or more additional purchase requests for additional items to be placed therein. As claimed, a selection of the first order processing route or the second order processing route may then be received by the customer (Step S82 in Fig. 8). As detailed in the specification, page 20, line 13 to page 21, line 2,

> **If express checkout has not been requested, a "shopping cart" may be created for this customer, as shown at S84. Within the context of the present invention, a "shopping cart" is a metaphor for a software construct enabling a customer to aggregate his or her online purchases for immediate or a later purchase. A shopping cart may be saved, deleted, modified or converted into an order by the customer at will. The shopping cart may be persistent until deleted, modified or converted and/or may be persistent for a predetermined or selectable period of time. The customer's purchase request placed in step S81 may be the single item placed in the shopping cart, or the customer may add items thereto, as shown at S85 and S86. As noted above, the customer may also add items to, remove items from, save or otherwise modify the cart (by modifying the quantity or other characteristics of the items in the cart). Therefore, steps S85 and S86 may be replaced with steps to remove or otherwise modify the shopping cart created in step S84.**

As claimed, the second order processing route (YES branch of S82 in Fig. 8) affords the customer an opportunity to cause execution of the first and any additional purchase requests placed in the shopping card to be processed according to the express ordering processing that requires no further input by the customer to execute, as stated in the specification, for example, at page 4, lines 18-20, page 7-lines 7-10 and 19-22, page 21, lines 3-7 and the Abstract. Finally, claim 1 calls for processing the first online purchase request according to the customer's selection (e.g., first or second order processing route, "Express Checkout Requested?" S82 of Fig. 8 and corresponding written description).

2. Dependent Claim 2

Dependent claim 2 is canceled.

3. Dependent Claim 3

Claim 3 calls for a step of enabling the customer to create a list 901 (see Fig. 9 and detailed description page 21, beginning at line 19) that includes the first and at least one second item, the list being persistently stored to enable later retrieval and processing according to the first or second order processing routes, as described in the specification at page 21, lines 6-9.

4. Dependent Claim 4

Claim 4 calls for the first item to include a uniquely identified and pre-stored list of goods and/or services. That is, the first item (the subject matter of the received first online purchase request), may itself include a (uniquely identified and pre-stored) list of goods and/or services, as shown in Fig. 10 at 1003, wherein any item may include a list of items. See page 22 of the specification also.

5. Dependent Claim 5

Claim 4 further defines an object as including at least one of another list and item. See, e.g., Fig. 10, reference numeral 1002 and page 22, lines 13-15.

6. Dependent Claim 6

Dependent Claim 6 is canceled

8. Dependent Claim 8

Dependent Claim 8 is canceled.

9. Dependent Claim 9

Dependent claim 9 claims the functionality shown and described relative to Fig. 1. Therein, the method of claim 1 is further recited to include steps of generating a first quote (see

quotes 1, 2 3 and 4 of Fig. 1) that includes the processed first online purchase request, the first quote including at least one of an identification of the first item and an identification of the shopping cart. The claim then calls for the first quote to persist for a consolidation interval 108, during which modifications may be made to the first quote. A converting step may then be carried out by converting the first quote into the first executable order (see Quote 1, 2 and 4 of Fig. 1) when a quote conversion process determines that the first quote has remained unmodified at least for the consolidation interval 108. See, e.g., the written description of Fig. 1 beginning at page 10, line 3.

10. Dependent Claim 10

The first quote generating step may, as claimed in dependent claim 10, include a step of generating an order status Web page that is viewable by the customer, the order status Web page displaying selected details of the first quote, as shown in Fig. 6 and as described in the specification beginning at page 19, line 17.

11. Dependent claim 11

The order status Web page may be configured to refer to the first quote as a pending order – see reference to "order" in Fig. 6.

12. Dependent Claim 12

Claim 12 calls for the customer, a selected process and/or an authorized person to be able to modify the first quote. As stated at page 11, lines 2-7 (See also Fig. 1):

> **Quotes, according to the present invention, are not immediately converted into an executable order. Instead, quotes persist for a period of time to allow the customer, other authorized persons and/or a selected automated process or processes to add further items to the generated quote, subtract items therefrom, cancel the quote or to generally modify any or selected payment, shipping and/or billing parameters.**

13. Dependent Claim 13

The authorized person of claim 12 may include, for example, the customer or a sales representative, as detailed at page 15, line 12-16, step S34 of Fig. 3, specification page 16, lines 101-4.

14. Dependent Claim 14

Claim 14 calls for the quote conversion process to be launched at a selectable interval, as described in the specification at page 16, lines 19-20.

15. Dependent Claim 15

Claim 15 calls for the consolidation interval 108 (Fig. 1) to be measured from a time at which the quote conversion process is launched.

16. Dependent Claim 16

Dependent claim 16 recites that the quote conversion process may run continuously, as described in the specification at page 12, lines 8-11: "According to the present invention, the quote conversion process may run continuously. If the quote conversion process runs continuously, quotes may be converted into corresponding executable orders that may be sent to an order fulfillment system as soon as the consolidation interval 108 set by the Web vendor elapses after generation of the quote."

17. Dependent Claim 17

This claim recites that the method may further include a step of converting the first and any second purchase request into an executable order and sending the executable order to an order fulfillment system, as shown in Fig. 1 (Order sent to Order Fulfillment system (OFS)) and step S89 in Fig. 8 and from page 10, line 20 to page 14, line 8, for example.

18. Dependent Claim 18

Claim 18 calls for the method to include receiving a second online purchase request for a second item from the customer over the computer network, and adding the second item to the first quote when the second online purchase request is received before the first quote is converted into the first order. See, for example, C2, C3, C7 and C8 in Fig. 1 and corresponding description from page 12, line 19 to page 16, line 2.

19. Dependent Claim 19

Claim 19 calls for the method to include steps of receiving a second online purchase request for a second item from the customer over the computer network, and adding the second item to the first quote when the quote conversion process determines that the first quote has remained unmodified for a period of time that is less than the consolidation interval. See, e.g., C3, C7, 116 (Fig. 1) wherein some modification of the pending quote occurred during the consolidation interval 108.

20. Dependent Claim 20

Dependent claim 20 calls for receiving a second online purchase request for a second item from the customer over the computer network, and generating a second quote that includes an identification of the second item and the retrieved information when the quote conversion process determines that the first quote has remained unmodified for a period of time greater than the consolidation interval. See, e.g., C2 in Fig. 1, which becomes quote 2 because it was received after the consolidation interval that ended at 12:00 am.

21. Dependent Claim 21

The quote conversion process, in dependent claim 21, is recited as determining a difference between a time at which a last modification to the first quote was made and a current time and converts the quote to the first order when the difference is greater than the consolidation interval. See order 1, 2 and 4 in Fig. 1 and corresponding description in the specification. Each of the quotes 1, 2 and 4 became orders because the difference between a time at which the last modification to the first quote (if any) and a current time is greater than the consolidation interval 108.

22. Dependent Claim 22

Dependent claim 22 calls for a step of sending a message to the customer over the computer network when the first quote is converted into the first order. As stated at page 20, liens 1-3: "When and if the quote is converted to an order, an email message may be automatically generated and sent to the email address specified at 508 in Fig. 5."

23. Dependent Claim 23

As recited, the message of claim 22 may include, for example, an email, an instant message, a voice message and/or a video message, as set forth in page 7, lines 1-3.

24. Independent Claim 24

Independent claim 24 recites a computer system 700 configured for processing an online purchase request from a customer to a vendor over a computer network 206. The computer system is recited as including at least one processor 702 (Fig. 7) and one or more data storage devices 704, 706, 707 (Fig. 7). See also detailed description of Fig. 7 under the heading "Hardware Description" at page 25, line 5. A plurality of processes are recited to be spawned by

the processor(s), the processes including processing logic for carrying out the steps discussed above in detail relative to claim 1. In the interest of avoiding repetitive description, a detailed description and listing of these steps is omitted. However, the detailed description of the steps of claim 1 is incorporated herein by reference, as if repeated here in full.

25. Dependent Claim 26-28, 30 and 32-46

The subject matter of dependent computer system claims 26-28, 30 and 32-46 corresponds to that of dependent method claims 3-5, 7, and 8-23, respectively. To avoid repeating the same description, the detailed description of these claims is incorporated herein by reference, as if repeated here in full.

26. Independent Claim 47

Independent claim 47 recites a machine-readable medium (e.g., see reference numerals 704, 706, 707 in Fig. 7) having data stored thereon representing sequences of instructions which, when executed by a computing device (e.g., 700), causes the computing device to process an online purchase request from a customer to a vendor over a computer network by performing the steps previously described relative to claim 1. In the interest of avoiding repetitive description, a detailed description and listing of these steps is omitted. However, the detailed description of the steps of claim 1 is incorporated herein by reference, as if repeated here in full.

27. Dependent Claim 49-51, 53 and 55-69

The subject matter of dependent computer system claims 49-51, 53 and 55-69 corresponds to that of dependent method claims 3-5, 7, and 8-23, respectively. To avoid repeating the same description, the detailed description of these claims is incorporated herein by reference, as if repeated here in full.

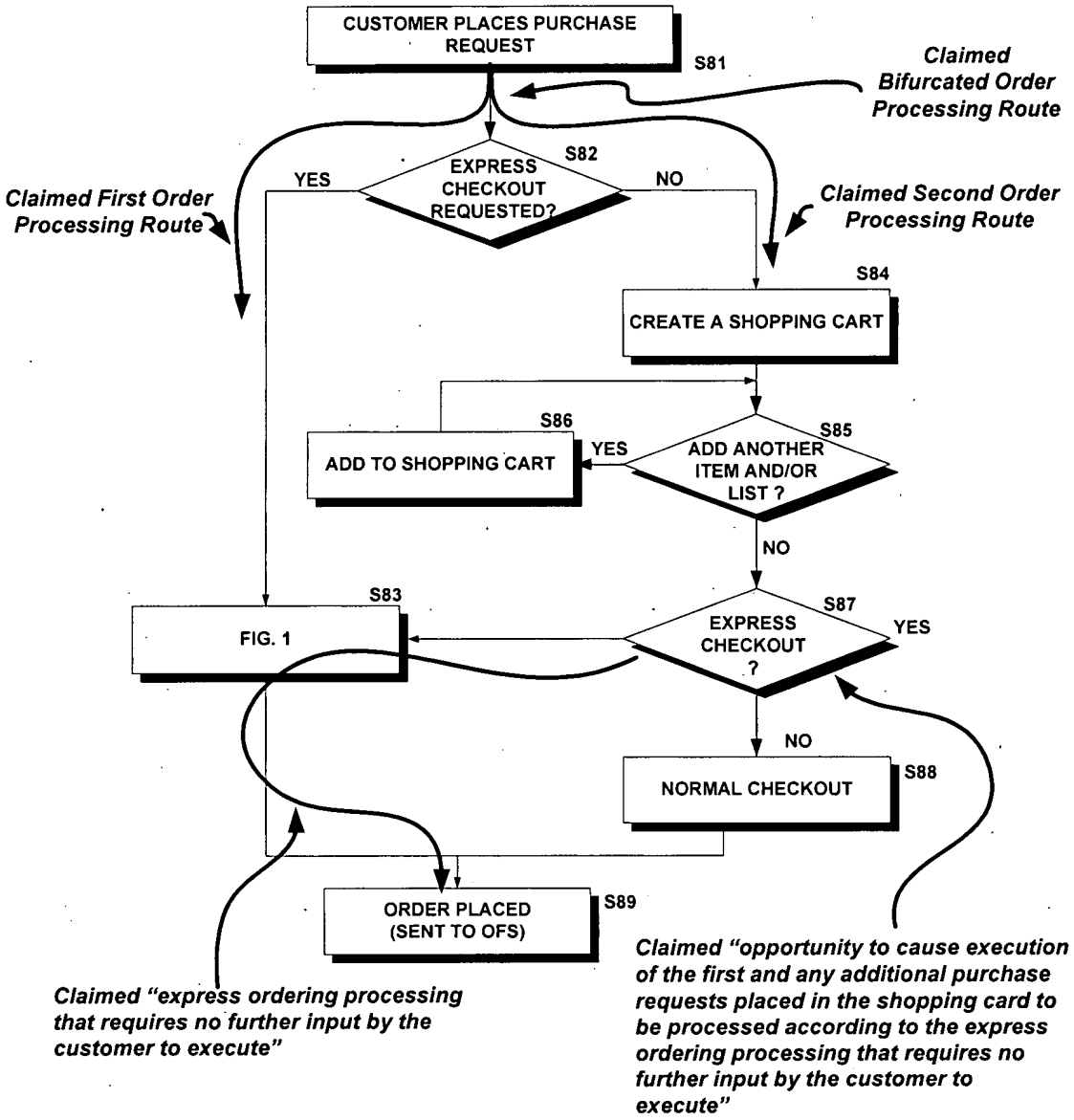
F. Grounds of Rejection to be Reviewed on Appeal

Whether claims 1, 3-5, 7, 9-24, 26-28, 30, 32-47, 49-51, 53 and 55-69 are unpatentable under 35 U.S.C. §103(a) over Barnes & Noble in view of Hartman et al., U.S. Patent No. 5,960,411 (hereinafter "B&N").

G. Arguments

Independent Claim 1

Reproduced below is Fig. 8 of the present application, annotated to show the claimed bifurcated order processing route, the claimed first order processing route, the claimed second order processing route and the claimed opportunity to cause execution of the first and any additional purchase requests placed in the shopping card to be processed according to the express ordering processing that requires no further input by the customer to execute.



Following fully seven pages of arguments, facts and citations in the amendment of January 4, 2007, the outstanding Final Office Action from which the present appeal is taken included the following response:

> ***Response to Arguments***
>
> In response to applicant's argument that cited reference B&N does not teach bifurcated processing route.

and:

> However, on page 37, B&N recites Check on an item you'd like to order (if ordering multiple items or gift wrapping required, add them to your cart)".

In response to Applicant's arguments relative to Hartman et al. and to the combination of B&N and Hartman et al., the Office fell back upon a non-substantive "separating the references" objection and barely two lines of substantive arguments that were not drawn to the actual claim language:

> Applicant is separating the cited references to make the argument. Hartman in Fig. 1A and 1B with the associated disclosure clearly teaches idea of processing of customer order using 1-click without further input from the user.

Indeed, the claimed embodiments are not the "idea" of using 1-click without further input from the user. Instead, claim 1 requires:

> ...
>
> **responsive to receiving the first online purchase request, providing a bifurcated order processing route that requests the customer to choose a first order processing route or a second order processing route, the first order processing route causing the first online purchase request to be processed according to an express processing procedure that requires no further input by the customer to execute the first online purchase request, the second order processing route causing the first online purchase request to be placed in a shopping cart that allows one or more additional purchase requests for additional items to be placed therein, the second order processing route affording the customer an opportunity to cause execution of the first and any additional purchase requests placed in the shopping card to be processed according to the express ordering processing that requires no further input by the customer to execute, and**

receiving from the customer a selection of the first order processing route or the second order processing route and processing the first online purchase request according to the customer's selection.

As may be seen, claim 1 does not define processing a customer order using 1-click without further input from the user. It is respectfully submitted to the Board that the Office has failed to show where, in the applied combination of references, there is a teaching or suggestion of the claimed bifurcated order processing route, of the first and second order processing routes of the bifurcated order processing route or any method or means for causing "execution of the first and any additional purchase requests placed in the shopping cart according to the express order processing route that requires no further input by the customer to execute," as claimed.

At the outset, it is noted that the Office Action mailed February 10, 2006, rejected these same claims as being anticipated by B&N and the Amendment filed March 31, 2006, was effective to overcome this rejection. In other words, the claims were acknowledged by the Office as not being anticipated by B&N. The Office now rejects the claims as being obvious over B&N in view of Hartman et al. That is, the Office relies on Hartman et al. to supply the teachings, suggestion and/or motivation that were acknowledged to be missing from B&N. Moreover, the Office has previously unambiguously stated that "Hartman does not disclose requesting customers to select an order processing route." See page 5, middle paragraph, Office Action of June 18, 2003. Therefore, unless Hartman et al. teaches or suggests the subject matter acknowledged to be missing from B&N (or does not teach what the Office asserts that it does), it is respectfully submitted to the Board that the outstanding rejection under §103(a) should be reversed and the application allowed – and not sent back to the Examiner for further (what have now become repetitive) office actions on previously applied art, as previously occurred when this case was remanded back to the Examiner following the first successful appeal.

It is respectfully submitted that B&N does not teach such a bifurcated order processing route, as claimed and as shown above. In particular, B&N does not teach a bifurcated order processing route that includes a second order processing route that affords the customer an opportunity to cause execution of the first and any additional purchase requests placed in the shopping cart according to the express order processing route that requires no further input by the customer to execute. B&N teaches to place items in a shopping cart, but does not teach processing the shopping cart according to the express order processing route that requires no further input by the customer.

In support of the rejection, the Office points to pages **12, 13, 28** and **37** of B&N as allegedly teaching the enumerated claim elements. B&N teaches, at page **12** of 35, at "How to Check Out the Items in Your Cart" to:

1) click the shopping cart link;
2) click Checkout Now;
3) enter customer information (if not already in the system);
4) click Continue; and
5) click Press Here to Send My Order.

As the Board can plainly see, this protracted process requires lots of "input by the customer to execute" and cannot be likened to the claimed causing "execution of the first and any additional purchase requests placed in the shopping cart according to the express order processing route that requires no further input by the customer to execute." Likewise, the section on page **13** of B&N referred to by the Office in the "How to Place an Order Using Express Lane" section does not teach any method or means for causing "execution of the first and any additional purchase requests placed in the shopping cart according to the express order processing route that requires no further input by the customer to execute," as claimed. Throughout the description of B&N's "Express Lane," the customer's purchase is referred to as "the item" (note the singular), and not as a shopping cart.

In addition to paged 12 and 13 discussed above, the Examiner also pointed to page **28**. As can be plainly seen, item 2 calls for "Click on the Express Checkout button. You'll be taken to a secure Confirmation Page which contains your shipping, billing and payment information." Item 3 states "Click the "Place Order" button. Therefore, B&N explicitly teaches that clicking a "Place Order" button (item 3) is necessary after a user clicks on the "Express Checkout" button (item 2) – this is a "further input" that is required, in contradistinction to the claimed embodiment that requires "no further input by the customer to execute." Therefore, page **28** of B&N also does not teach any method or means for causing "execution of the first and any additional purchase requests placed in the shopping cart according to the express order processing route that requires no further input by the customer to execute," as claimed.

Lastly, page **37** of B&N teaches the same process whereby a user must first click on the "Express Checkout" button (item 2. on page 37) and thereafter must click on the "Place Order" button (item 3. on page 37), which is contrary to the claims, which require "execution of the first and any additional purchase requests placed in the shopping cart according to the express order processing route that requires no further input by the customer to execute." *(Underlining for emphasis only.)*

The Office acknowledged as much when, beginning at page 4, line 7 of the outstanding Final Office Action, the Examiner stated: "B&N does not teach processing the order without further input of the user," but asserted that "Hartman teaches the idea of process customer order using express ordering processing (1-click) without further input from the user."

Hartman et al., however does not teach or suggest executing a first and any additional purchase requests placed in the shopping cart according to the express order processing route that requires no further input by the customer to execute, as claimed herein. Instead, Hartman et al.

disclose enabling a single action (usually, a single mouse click) ordering functionality for a single item order. After selecting an item and single action ordering the selected item, the customer is given an opportunity to review change the single action order (Col. 5, lines 3-9). To help minimize shipping costs and purchaser confusion, the server system may combine various single-action orders (Col 5, lines 26-28). Hartman et al.'s server system may also combine single action orders that are placed within a certain time period (e.g., 90 minutes). Orders placed may be combined or divided, based upon availability of the items ordered (Col. 4, lines 47-55, Col. 7, lines 24-56). Hartman et al. then teaches an algorithm for expedited order selection. The stated goal for this algorithm is to reduce the shipping costs (Col. 8, line 1 through Col. 9, line 7).

In the background section of this reference, Hartman et al. speaks of the drawbacks inherent in the shopping cart model:

> **Although the shopping cart model is very flexible and intuitive, it has a downside in that it requires many interactions by the purchaser. For example, the purchaser selects the various items from the electronic catalog, and then indicates that the selection is complete. The purchaser is then presented with an order Web page that prompts the purchaser for the purchaser-specific order information to complete the order. That Web page may be prefilled with information that was provided by the purchaser when placing another order. The information is then validated by the server computer system, and the order is completed. Such an ordering model can be problematic for a couple of reasons. If a purchaser is ordering only one item, then the overhead of confirming the various steps of the ordering process and waiting for, viewing, and updating the purchaser-specific order information can be much more than the overhead of selecting the item itself. This overhead makes the purchase of a single item cumbersome. Also, with such an ordering model, each time an order is placed sensitive information is transmitted over the Internet. Each time the sensitive information is transmitted over the Internet, it is susceptible to being intercepted and decrypted (Col. 2, lines 26-48).**

Thereafter, Hartman et al. makes it clear that the single-action ordering scheme disclosed therein is not related to the shopping cart model whose disadvantages are outlined in the background section. Indeed, specifically addressing the disadvantages of the shopping cart model outlined in the Background section, Hartman et al.'s claim 1 recites that the item ordered via the

single-action model is ***"ordered without using a shopping cart ordering model."*** Hartman et al. claim 1, lines 35-36). In addition, Hartman et al.'s claim 11, at lines 28-30, recites:

> **...whereby the item is ordered independently of a shopping cart model and the order is fulfilled to complete a purchase of the item.**

Fig. 1A of Hartman et al. makes it abundantly clear, moreover, that the 1-click ordering scheme disclosed therein is designed for ordering an item - and not for processing the contents of a shopping cart. Indeed, the reference to 1-click in Hartman et al.'s Fig. 1A is grouped under the reference numeral 103, which relates to purchasing a single item, as opposed to reference numeral 102, which relates to the shopping cart model (Col. 4 lines 4-33). There does not appear to be any teaching or suggestion in the Hartman et al. reference of applying the 1-click model to the contents of a shopping cart. Such would be contrary to the claims in this patent, and would not address any of the disadvantages identified in the Background section thereof. It is to be noted that Hartman et al. is very specific as to the use of the disclosed single action or "1-click" ordering scheme: "This example single-action ordering section allows the purchaser to specify with a single click of a mouse button to order the described item" (Col. 4, lines 31-33) (Emphasis Added). Hartman et al. pointedly do not state, suggest or allow for any reasonable suggestion that the single action ordering section allows the purchaser to specify with a single click of a mouse button to order the items in the shopping cart - and explicitly teaches away from such a concept, for the reasons identified in Hartman et al.'s own Background section. As the Board is aware, a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). In this case, Hartman et al., specifically and categorically teach that their method is inapplicable to shopping carts. Therefore, for the Examiner to contradict the explicit and unambiguous teachings of the

reference and assert that Hartman et al.'s method is applicable to shopping carts and to thereafter apply that factually inaccurate interpretation of the reference in the context of a §103(a) rejection is believed to be improper.

The independent claims on appeal recite:

> **...the second order processing route affording the customer an opportunity to cause execution of the first and any additional purchase requests placed in the shopping card to be processed according to the express ordering processing that requires no further input by the customer to execute.**

Therefore, to specifically address the Examiner's assertion that "Applicant is separating the references to make the argument" (outstanding Office Action, page 2, last paragraph), the applicant's representative submits the following. It is respectfully submitted that a person of ordinary skill in the art, even in full possession of the B&N and Hartman et al. references, would not devise the claimed embodiments or somehow be motivated to make the changes necessary to achieve the claimed embodiments. Instead, the person of ordinary skill in the art would be motivated devise a method for placing an order without the shopping cart model in response to a single action being performed (such as a click, for example) when the order is for a single item, as taught by Hartman et al., and to require an additional input from the customer when a shopping cart model is used, as explicitly taught be B&N. It is respectfully submitted that there are no grounds in the applied references for a person of ordinary skill in the art armed with both the B&N and Hartman et al. references to, somehow, develop or become motivated to develop methods or means for causing "execution of the first and any additional purchase requests placed in the shopping cart according to the express order processing route that requires no further input by the customer to execute," as claimed herein – when the references specifically point away (with unambiguous limiting statements) from such an embodiment. This is because neither of the two

applied references, whether considered alone or in combination, teach or suggest the claimed bifurcated order processing route or the execution of orders placed in a shopping cart in a manner that requires no further input by the customer to execute. Indeed, what is acknowledged to be missing from the primary reference to B&N is explicitly disavowed in the secondary reference to Hartman et al. (because Hartman et al. go to great lengths to state that their method is "independent of the shopping cart model" or carried out "without using a shopping cart model"). Therefore, that which is explicitly acknowledged to be missing from the primary reference is also explicitly missing from the secondary reference, which is believed fatal to the applied §103(a) rejections.

Indeed, the plain and explicit teachings of Hartman et al. are that the item ordered via the single-action model discussed in Fig. 4 is *"ordered without using a shopping cart ordering model"* (Hartman et al. claim 1, lines 35-36). In addition, Hartman et al.'s claim 11, at lines 28-30, recites "*...whereby the item is ordered independently of a shopping cart model and the order is fulfilled to complete a purchase of the item."* In addition, Fig. 4 and its associated description at Col. 7, lines 4-23 describe how to generate a Web page in which such single-action ordering is enabled. Such Web page includes information such as the customer's name and a portion of the customer's credit card information. Fig. 5, beginning at Col. 7, line 24, describes how a single-action ordering for an item may be combined with other items ordered via the single-action ordering mechanism (if combined within 90 minutes, for example), in order to save on shipping costs. However, Hartman et al., contrary to what is asserted by the Office, do not teach the presently claimed second order processing route whereby the customer is afforded the opportunity to cause execution of the first and any additional purchase requests placed in the shopping cart to be processed according to the express ordering processing that requires no further input by the customer. Such a teaching is only found in the pending application.

In view of the above, it is respectfully submitted that the applied combination is not effective to render the claimed subject matter obvious. Indeed, the claims have previously been distinguished over the B&N reference within the context of anticipation. In the most recent Office Action, the Office added the Hartman et al. reference in an attempt to supply the teachings acknowledged to be missing from the B&N reference. However, the text of Hartman et al. and arguments above effectively demonstrate that the Hartman et al. reference does not teach the subject matter acknowledged to be missing from the primary reference. Therefore, it is respectfully submitted that the applied combination of B&N and Hartman et al. do not teach or suggest the claimed subject matter, whether the references are considered singly or in combination as they must in the context of a §103(a) rejection. In order to establish a prima facie case of obviousness under 35 U.S.C. § 103, each and every element of the claimed invention must be disclosed in the combination of documents applied. Because at least one element of Applicant's claimed embodiment (e.g., the second order processing route affording the customer an opportunity to cause execution of the first and any additional purchase requests placed in the shopping card to be processed according to the express ordering processing that requires no further input by the customer to execute) is not disclosed or suggested in the combination of applied references, Applicant respectfully submits that no prima facie case of obviousness has been established. The applied §103(a) rejections applied to claim 1 and its dependent claims, therefore, are believed to be untenable and should be reversed.

Computer system independent claim 24 and media independent claim 47 include similar recitations and are believed to be independently patentable over the applied combination of references for the same reasons. Therefore, rather than repeat the above arguments for each of

independent claims 24 and 47, the arguments advanced above relative to claim 1 are incorporated herein by reference, as if repeated here in full.

Dependent Claims 3, 26 and 49

Dependent claim 3, 26 and 49 recite:

> **...a step of enabling the customer to create a list that includes the first and at least one second item, the list being persistently stored to enable later retrieval and processing according to the first or second order processing routes.**

In rejecting claims 3, 26 and 49, the Examiner pointed to B&N pages 12 and 37. However, these B&N pages teach the mechanics of placing orders with a shopping cart or via B&N's Express Lane. In contradistinction, the claimed list is a list that includes a first and at least one second item, and that is persistently stored to enable later retrieval and processing according to the first or second order processing routes. The claimed list, therefore, are not shopping carts. Instead, as taught in the present application at page 21, beginning at line 19:

> **A list, according to the present invention, may include any number of items, each predefined or configurable. For example, item 1 of the list 901 may include a basic personal computer, item 2 may include a monitor, item 3 may include a hard drive of a given capacity and item 3 may include a processor of a given type or speed. Together, the list 901 may, therefore, include a fully configured personal computer suitable for a new hire of a corporate customer. Therefore, using a list such as shown at 901, a company may simply select list 901 each time it wishes to purchase a new computer setup, rather than individually configuring the computer and selecting each constituent component thereof individually. Lists, according to the present invention, may be ordered (made the subject of a purchase request) following the express ordering procedure and/or placed in a new shopping cart or added to an existing shopping cart that stores other items and/or lists.**

That B&N describes shopping carts is not believed to render claims 3, 26 and 49 unpatentable over a combination of B&N and Hartman et al. Indeed, B&N, whether considered singly or in combination with Hartman et al., is not believed to teach or to suggest a list that is persistently stored to enable later retrieval and processing according to the first or second order

processing routes, as required herein. The Board, therefore, is respectfully requested to reconsidered and overturn the §103(a) rejection of these claims.

Dependent Claims 4, 27 and 50

Dependent claims 4, 27 and 50 recite:

> **...the first item includes a uniquely identified and pre-stored list of goods and/or services.**

Therefore, the first item of the previously claimed list (see claims 3, 26 and 49) is further recited in claims 4, 27 and 50 to include a uniquely identified and pre-stored list of goods and/or services. Therefore, claims 4, 27 and 50 recite a list (claims 3, 26, 49) which in itself includes a uniquely identified and pre-stored list of goods and/or services – a list that includes, as one of its elements, another list. In rejecting these claims, the Office relied on pages 12, 13 and 37 of B&N which, as previously noted, discloses no such lists, but simply discloses a shopping cart into which the customer may place one or more items. There is no teaching or suggestion in B&N or in the applied combination of references, of any list that includes a uniquely identified and pre-stored list of goods and/or services that persistently stored to enable later retrieval and processing according to the first or second order processing routes, as required by claims 4, 27 and 50. A teaching of a shopping cart (whether according to B&N and/or Hartman et al.) does not, without more, rise to the level of a teaching or a suggestion of a list having another list as one of its elements, as recited in claims 4, 27 and 50. The Board, therefore, is respectfully requested to reconsidered and overturn the §103(a) rejection of these claims.

Dependent Claims 5, 28 and 51

Claims 5, 28 and 51 introduce an object. As claimed, the object is an element of the list, and one or more lists and an item. Therefore, the claimed list, according to the embodiments of

claims 5, 28 and 51 may include an object as an element thereof, the object comprising a list and an item:

> **5. (Original) The method of claim 4, wherein the list includes an object, the object including at least one of another list and [sic, an] item.**

Here, the Examiner specifically states that the claimed list is the shopping cart of B&N in view of Hartman et al. However, B&N in view of Hartman et al. does not teach or suggest any shopping cart in which one of the items placed in the shopping cart comprises a list and one or more items. As disclosed on page 22, liens 9-11 of the specification,

> **As shown at Fig. 10, a list 1001 may include an object (or several objects) 1002. An object, according to the present invention, may include or more items and/or one or more lists of items and/or lists**

The shopping cart model of B&N and Hartman et al. is not disclosed to support objects, as claimed herein – nor has the Office pointed to any specific teaching in the applied combination that discloses or suggests this subject matter. Therefore, the Board is respectfully requested to reconsidered and overturn the §103(a) rejection of claims 5, 29 and 51.

None of the claims are unpatentable over the applied combinations. Therefore, Appellant respectfully requests a reversal of the rejections and a finding that the pending claims are allowable. An oral hearing is not requested.

Respectfully submitted,

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H. Claims Appendix

1. **(Previously Presented)** A computer-implemented method of processing an online purchase request from a customer to a vendor over a computer network, comprising the steps of:

receiving, over the computer network, a first online purchase request for a first item;

responsive to receiving the first online purchase request, providing a bifurcated order processing route that requests the customer to choose a first order processing route or a second order processing route, the first order processing route causing the first online purchase request to be processed according to an express processing procedure that requires no further input by the customer to execute the first online purchase request, the second order processing route causing the first online purchase request to be placed in a shopping cart that allows one or more additional purchase requests for additional items to be placed therein, the second order processing route affording the customer an opportunity to cause execution of the first and any additional purchase requests placed in the shopping card to be processed according to the express ordering processing that requires no further input by the customer to execute, and

receiving from the customer a selection of the first order processing route or the second order processing route and processing the first online purchase request according to the customer's selection.

2. **(Cancelled)**

3. **(Previously Presented)** The method of claim 2, further including a step of enabling the customer to create a list that includes the first and at least one second item, the list being persistently stored to enable later retrieval and processing according to the first or second order processing routes.

4. **(Original)** The method of claim 1, wherein the first item includes a uniquely identified and pre-stored list of goods and/or services.

5. **(Original)** The method of claim 4, wherein the list includes an object, the object including at least one of another list and item.

6. **(Cancelled)**

7. **(Original)** The method of claim 1, wherein the customer identifies the first item using a unique identifier used by the customer and wherein the vendor maps the identifier used by the customer to a corresponding unique identifier used by the vendor.

8. **(Cancelled)**

9. **(Original)** The method of claim 1, further including the steps of:

generating a first quote that includes the processed first online purchase request, the first quote including at least one of an identification of the first item and an identification of the shopping cart;

enabling modifications to be made to the first quote, the first quote persisting at least until a consolidation interval has elapsed, and

carrying out the converting step by converting the first quote into the first executable order when a quote conversion process determines that the first quote has remained unmodified at least for the consolidation interval.

10. **(Original)** The method of claim 1, wherein the first quote generating step includes a step of generating an order status Web page that is viewable by the customer, the order status Web page displaying selected details of the first quote.

11. **(Original)** The method of claim 10, wherein the order status Web page is configured to refer to the first quote as a pending order.

12. **(Previously Presented)** The method of claim 9, wherein the enabling step allows at least one of the customer, a selected process and an authorized person to modify the first quote.

13. **(Previously Presented)** The method of claim 12, wherein the authorized person includes the customer and a sales representative.

14. **(Original)** The method of claim 9, wherein the quote conversion process is launched at a selectable interval.

15. **(Original)** The method of claim 14, wherein the consolidation interval is measured from a time at which the quote conversion process is launched.

16. **(Original)** The method of claim 9, wherein the quote conversion process runs continuously.

17. **(Previously Presented)** The method of claim 1, further comprising the step of converting the first and any second purchase request into an executable order and sending the executable order to an order fulfillment system.

18. **(Previously Presented)** The method of claim 9, further comprising the steps of:

receiving a second online purchase request for a second item from the customer over the computer network, and

adding the second item to the first quote when the second online purchase request is received before the first quote is converted into the first order.

19. **(Previously Presented)** The method of claim 9, further comprising the steps of:

receiving a second online purchase request for a second item from the customer over the computer network, and

adding the second item to the first quote when the quote conversion process determines that the first quote has remained unmodified for a period of time that is less than the consolidation interval.

20. **(Previously Presented)** The method of claim 9, further comprising the steps of:

receiving a second online purchase request for a second item from the customer over the computer network, and

generating a second quote that includes an identification of the second item and the retrieved information when the quote conversion process determines that the first quote has remained unmodified for a period of time greater than the consolidation interval.

21. **(Original)** The method of claim 9, wherein the quote conversion process determines a difference between a time at which a last modification to the first quote was made and a current time and converts the quote to the first order when the difference is greater than the consolidation interval.

22. **(Previously Presented)** The method of claim 9, further comprising the step of sending a message to the customer over the computer network when the first quote is converted into the first order.

23. **(Original)** The method of claim 22, wherein the message includes one of an email, an instant message, a voice message and a video message.

24. **(Previously Presented)** A computer system configured for processing an online purchase request from a customer to a vendor over a computer network, comprising:

at least one processor;

at least one data storage device;

a plurality of processes spawned by said at least one processor, the processes including processing logic for:

receiving, over the computer network, a first online purchase request for a first item;

responsive to receiving the first online purchase request, providing a bifurcated order processing route that requests the customer to choose a first order processing route or a second order processing route, the first order processing route causing the first online purchase request to be processed according to an express processing procedure that requires no further input by the customer to execute the first online purchase request, the second order processing route causing the first online purchase request to be placed in a shopping cart that allows one or more additional purchase requests for additional items to be placed therein, the second order processing route affording the customer an opportunity to cause execution of the first and any additional purchase requests placed in the shopping card to be processed according to the express ordering processing that requires no further input by the customer to execute, and

receiving from the customer a selection of the first order processing route or the second order processing route and processing the first online purchase request according to the customer's selection.

25. **(Cancelled)**

26. (**Previously Presented**) The computer system of claim 24, further including a process for carrying out a step of enabling the customer to create a list that includes the first and at least one second item, the list being persistently stored to enable later retrieval and processing according to the first or second order processing routes.

27. **(Original)** The computer system of claim 24, wherein the first item includes a uniquely identified and pre-stored list of goods and/or services.

28. **(Original)** The computer system of claim 27, wherein the list includes an object, the object including at least one of another list and item.

29. **(Cancelled)**

30. **(Original)** The computer system of claim 24, wherein the customer identifies the first item using a unique identifier used by the customer and wherein the vendor maps the identifier used by the customer to a corresponding unique identifier used by the vendor.

31. **(Cancelled)**

32. **(Original)** The computer system of claim 24, further including the processes for carrying out the steps of:

generating a first quote that includes the processed first online purchase request, the first quote including at least one of an identification of the first item and an identification of the shopping cart;

enabling modifications to be made to the first quote, the first quote persisting at least until a consolidation interval has elapsed, and

carrying out the converting step by converting the first quote into the first executable order when a quote conversion process determines that the first quote has remained unmodified at least for the consolidation interval.

33. **(Original)** The computer system of claim 32, wherein the first quote generating step includes a step of generating an order status Web page that is viewable by the customer, the order status Web page displaying selected details of the first quote.

34. **(Original)** The computer system of claim 33, wherein the order status Web page is configured to refer to the first quote as a pending order.

35. **(Previously Presented)** The computer system of claim 32, wherein the enabling step allows at least one of the customer, a selected process and an authorized person to modify the first quote.

36. **(Previously Presented)** The computer system of claim 35, wherein the authorized person includes the customer and a sales representative.

37. **(Original)** The computer system of claim 32, wherein the quote conversion process is launched at a selectable interval.

38. **(Original)** The computer system of claim 37, wherein the consolidation interval is measured from a time at which the quote conversion process is launched.

39. **(Original)** The computer system of claim 32, wherein the quote conversion process runs continuously.

40. **(Previously Presented)** The computer system of claim 24, further comprising the step of converting the first and any additional purchase requests into an executable order and sending the executable order to an order fulfillment system.

41. **(Previously Presented)** The computer system of claim 32, further comprising the steps of:

receiving a second online purchase request for a second item from the customer over the computer network, and

adding the second item to the first quote when the second online purchase request is received before the first quote is converted into the first order.

42. **(Previously Presented)** The computer system of claim 32, further comprising the steps of:

receiving a second online purchase request for a second item from the customer over the computer network, and

adding the second item to the first quote when the quote conversion process determines that the first quote has remained unmodified for a period of time that is less than the consolidation interval.

43. **(Previously Presented)** The computer system of claim 32, further comprising processes for carrying out the steps of:

receiving a second online purchase request for a second item from the customer over the computer network, and

generating a second quote that includes an identification of the second item and the retrieved information when the quote conversion process determines that the first quote has remained unmodified for a period of time greater than the consolidation interval.

44. **(Original)** The computer system of claim 32, wherein the quote conversion process determines a difference between a time at which a last modification to the first quote was made and a current time and converts the quote to the first order when the difference is greater than the consolidation interval.

45. **(Previously Presented)** The computer system of claim 32, further comprising a process for carrying out the step of sending a message to the customer over the computer network when the first quote is converted into the first order.

46. **(Original)** The computer system of claim 45, wherein the message includes one of an email, an instant message, a voice message and a video message.

47. **(Previously Presented)** A machine-readable medium having data stored thereon representing sequences of instructions which, when executed by computing device, causes said

computing device to process an online purchase request from a customer to a vendor over a computer network by performing the steps of:

receiving, over the computer network, a first online purchase request for a first item;

responsive to receiving the first online purchase request, providing a bifurcated order processing route that requests the customer to choose a first order processing route or a second order processing route, the first order processing route causing the first online purchase request to be processed according to an express processing procedure that requires no further input by the customer to execute the first online purchase request, the second order processing route causing the first online purchase request to be placed in a shopping cart that allows one or more additional purchase requests for additional items to be placed therein, the second order processing route affording the customer an opportunity to cause execution of the first and any additional purchase requests placed in the shopping card to be processed according to the express ordering processing that requires no further input by the customer to execute, and

receiving from the customer a selection of the first order processing route or the second order processing route and processing the first online purchase request according to the customer's selection.

48. **(Cancelled)**

49. **(Previously Presented)** The medium of claim 47, further including a step of enabling the customer to create a list that includes the first and at least one second item, the list being persistently stored to enable later retrieval and processing according to the first or second order processing routes.

50. **(Original)** The medium of claim 47, wherein the first item includes a uniquely identified and pre-stored list of goods and/or services.

51. **(Original)** The medium of claim 50, wherein the list includes an object, the object including at least one of another list and item.

52. **(Cancelled)**

53. **(Original)** The medium of claim 47, wherein the customer identifies the first item using a unique identifier used by the customer and wherein the vendor maps the identifier used by the customer to a corresponding unique identifier used by the vendor.

54. **(Cancelled)**

55. **(Original)** The medium of claim 47, further including the steps of:

generating a first quote that includes the processed first online purchase request, the first quote including at least one of an identification of the first item and an identification of the shopping cart;

enabling modifications to be made to the first quote, the first quote persisting at least until a consolidation interval has elapsed, and

carrying out the converting step by converting the first quote into the first executable order when a quote conversion process determines that the first quote has remained unmodified at least for the consolidation interval.

56. **(Original)** The medium of claim 55, wherein the first quote generating step includes a step of generating an order status Web page that is viewable by the customer, the order status Web page displaying selected details of the first quote.

57. **(Original)** The medium of claim 56, wherein the order status Web page is configured to refer to the first quote as a pending order.

58. **(Previously Presented)** The medium of claim 55, wherein the enabling step allows at least one of the customer, a selected process and an authorized person to modify the first quote.

59. **(Previously Presented)** The medium of claim 58, wherein the authorized person includes the customer and a sales representative.

60. **(Original)** The medium of claim 55, wherein the quote conversion process is launched at a selectable interval.

61. **(Original)** The medium of claim 60, wherein the consolidation interval is measured from a time at which the quote conversion process is launched.

62. **(Original)** The medium of claim 55, wherein the quote conversion process runs continuously.

63. **(Previously Presented)** The medium of claim 47, further comprising the step of converting the first and any additional purchase requests into an executable order and sending the executable order to an order fulfillment system.

64. **(Previously Presented)** The medium of claim 47, further comprising the steps of:

receiving a second online purchase request for a second item from the customer over the computer network, and

adding the second item to the first quote when the second online purchase request is received before the first quote is converted into the first order.

65. **(Previously Presented)** The medium of claim 47, further comprising the steps of:

receiving a second online purchase request for a second item from the customer over the computer network, and

adding the second item to the first quote when the quote conversion process determines that the first quote has remained unmodified for a period of time that is less than the consolidation interval.

66. **(Previously Presented)** The medium of claim 47, further comprising the steps of:

receiving a second online purchase request for a second item from the customer over the computer network, and

generating a second quote that includes an identification of the second item and the retrieved information when the quote conversion process determines that the first quote has remained unmodified for a period of time greater than the consolidation interval.

67. **(Original)** The medium of claim 47, wherein the quote conversion process determines a difference between a time at which a last modification to the first quote was made and a current time and converts the quote to the first order when the difference is greater than the consolidation interval.

68. **(Previously Presented)** The medium of claim 47, further comprising the step of sending a message to the customer over the computer network when the first quote is converted into the first order.

69. **(Original)** The medium of claim 68, wherein the message includes one of an email, an instant message, a voice message and a video message.

I. Evidence Appendix

B&N primary reference additional pages.

J. Related Proceedings Appendix

There are no related proceedings.